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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,766	11/29/2000	John M. Davidson	020533.0340	1919

7590

12/21/2005

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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/726,766

Applicant(s)

DAVIDSON ET AL.

Examiner

Philip C. Lee

Art Unit

2154

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1,3-24,26-33 and 35-45.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached paper.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

1. The request for reconsideration has been entered and considered but it is not persuasive.
2. In the remarks, applicant argues that
 - (1) Rejection under section 101 should be withdrawn because "computer readable medium" is patentable subject matter.
 - (2) May did not teach encapsulating a DHCP message within a point-to-point message.
3. In response to point (1), "computer readable medium" that includes carrier wave or a signal are non-statutory due to the "Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility" that was signed on Oct 26 and posted on the uspto.gov website. The link is: <http://www.uspto.gov/web/offices/pac/dapp/ogsheet.html>. Please see the issues of functional and nonfunctional descriptive material, as well as signals and carrier waves (currently not considered suitable computer-readable media in and of themselves). These are discussed in detail in about the last 10 pages of the Guidelines (Annexes 4 and 5). Please note that these interim guidelines supercede those in MPEP 2106. Thus the interim guidelines should be turned to and followed for instances where you previously turned to MPEP 2106.
4. Data structures, software, and computer program products that lack storage on a suitable computer-readable medium are not able to realize any functionality and are thus not statutory. The commonly granted patents cited by the applicant in the remark submitted on 11/21/05 were granted prior to the rule change.

5. In response to point (2), applicant argument was presented and addressed to in the Final Office Action mailed on 9/21/05. On page 4, paragraph 1 of the remark submitted on 11/21/05, applicant's argument is addressed to only one reference, May, U.S. Patent Application Publication 2001/0030977, however, the limitation "encapsulating a DHCP message within a point-to-point message" was taught by May, U.S. Patent Application Publication 2001/0030977 (hereinafter May) in view of Shukla, U.S. Patent Application Publication 2002/0042875 (hereinafter Shukla). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, May taught the invention substantially as claimed for communicating with an element within an enterprise network, comprising:

at a first client, converting a first point-to-point protocol signal (e.g. PPP packet) into a network address request protocol packet (e.g. DHCP) (page 4, paragraph 49), the first point-to-point protocol signal comprising a point-to-point protocol header that includes an identifier of a second client (inherently comprised in the PPP packet).

May did not specifically detailing the packet conversion between the point-to-point layer and the network address protocol layer comprises encapsulating the point-to-point signal (e.g. PPP packet) within a network address request header. Shukla taught that the packet conversion between protocol layers comprises each protocol layer encapsulating its own header before transmitting to the next layer (page 1, paragraph 3). It is noted that examiner did not relied on Shukla's teaching of the Open Systems Interconnection (OSI) model of encapsulation, but rather

the Shukla's teaching of header can be encapsulated to another protocol signal. As shown in figure 5, Shukla taught encapsulating an original packet with its own header within another header. Thus, the combination of May and Shukla taught encapsulating a DHCP message within a point-to-point message.